

REMARKS

This is in response to the Final Office Action of March 8, 2004 in which the Examiner rejected claims 11, 13-16 and 20 under 35 U.S.C. § 103 over Fields (U.S. Pat. No. 6,605,120).

Applicant respectfully submits that the Final Rejection is premature and requests reconsideration and withdrawal of the Final Rejection under MPEP § 706.07(d). In the Office Action of September 25, 2003, the Examiner applied Fields to the pending claims and stated that: "Claims 12-15, 19-20 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims." Applicant's response of December 23, 2003 included an amendment in which claims 11, 13-16, and 20 were amended in the manner indicated by the Examiner for the allowable subject matter of claims 12-15 and 19-20. In the Final Rejection the Examiner rejected claims 11, 13-16, and 20 based on Fields.

Under MPEP § 706.07(a) it is improper for the Examiner to issue a final rejection on a second action "where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." In the present Final Rejection, the Examiner has rejected subject matter previously considered allowable over the same reference. Nothing that Applicant has done necessitated the new ground of rejection. Applicant has not previously had a chance to respond to the basis of the rejection of claims 11, 13-16, and 20. Consequently, withdrawal of the final rejection is appropriate.

Applicant has amended the independent claims to clarify differences between Applicant's claimed invention and the cited art. As amended, the claims clarify that a sequence of actions of a user to reach a target page are recorded, that the target pattern is for a selected subset of elements of interest to the user, and that information of interest to the user is automatically extracted. New claims 21-28 include limitations found in the original claims along with similar clarifying language. For example, independent claim 21 has limitations in common with original claim 11 whereas independent claim 25 has limitations in common with original claim 16.

One benefit of Applicant's claimed invention is that it permits a user to define a navigation path and a target pattern to access information of interest to a user from an electronic

document. The target page is then automatically accessed for the user and information of interest to the user is extracted based on the target pattern.

Fields describes a technique for a hosting site to host web pages of a content provider. As described in column 4, lines 63-66, an end-user at a client computer 113 first accesses a hosting site 103. The end-user, while browsing at the hosting site 103, then selects a web-page of a content provider. The web-page of the content provider is provided by a pass-through mechanism in which the hosting site accesses the web page of the content provider and recasts it to have the "look and feel of the hosting Web site" as described in column 4, lines 40-43 and column 5, lines 12-23 of the Fields patent.

Note that in Fields the end-user at a client computer 113 has no control over the recasting process. The end-user is provided with recasted content but has no ability to select a subset of the content that is of interest to them for automatic extraction. Thus in Fields the end-user at a client computer 113 has no capability to automatically access and extract information of interest to the end-user.

As previously described, the independent claims include language clarifying that the user has the capability to define a sequence of actions of a user to navigate to a target page, that a target pattern is identified for information of interest to the user, and that information of interest to the user is automatically extracted from the target page.

Regarding claims 11, 16, 21, and 25, Fields does not teach or suggest the element of recording a sequence of actions of the user to navigate to a target page. In Fields, the end-user accesses content by browsing the host web-site. The host web-site of Fields is configured with the URLs of the content providers, as described in column 4, lines 55-57. There is no teaching or suggestion in Fields of recording the sequence of actions of the user to navigate to a target page.

Regarding claims 11, 16, 21, and 25, Fields does not teach or suggest the element of identifying a target pattern for a selected subset of said plurality of elements of interest to said user. As previously described, in Fields an end user at a client computer has no capability to define a subset of information of interest. Consequently, Fields does not identify a target pattern for the information of interest to the user.

Regarding claims 11, 16, 21, and 25, Fields does not teach or suggest the element of automatically accessing said target page according to said recorded sequence. As previously

described, Fields does not record a sequence of actions of the user to navigate to the target page. Moreover, there is no teaching or suggestion in Fields for automatically accessing a target page. In contrast, Fields teaches that an end user at a client computer 113 manually browses a host web-site to access content.

Regarding claims 11, 16, 21, and 25, Fields does not teach or suggest the element of automatically identifying and copying select ones of said plurality of elements. As previously described, in Fields an end user at a client computer 113 has no capability to have a selected subset of information automatically extracted for them.

The dependent claims are allowable for at least the same reasons and include additional limitations as well. Consequently, in view of the foregoing amendments and remarks, it is respectfully submitted that all pending claims in the application are now in a condition for allowance. The Examiner is invited to contact the undersigned if there are any residual issues that can be resolved through a telephone call.

The Commissioner is hereby authorized to charge any appropriate fees to Deposit Account No 03-3117.

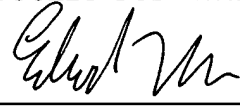
Dated: _____

May 3, 2004

Cooley Godward LLP
ATTN: Patent Group
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663

Respectfully submitted,
COOLEY GODWARD LLP

By: _____


Edward A. Van Gieson
Reg. No. 44,386